

### **REMARKS**

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.112 and in light of the remarks which follow.

Claims 15-22, 29-33, 35-41 and 43 are pending in the application, Claims 34 and 42 having been canceled above without prejudice to or disclaimer of the subject matter therein.

By the above amendments, Applicants amended Claims 15 and 30 to address minor informalities and § 112 issues. Applicants also canceled Claims 34 and 42 in view of clarifying amendments made to Claims 15 and 30. Finally, Applicants amended Claims 35 and 43 to make these claims consistent with amendments made to the independent claims. A claim that has been amended in a manner that does not narrow the claim's scope should be accorded its full range of equivalents.

Applicants thank the Examiner for his consideration of the Amendment filed December 24, 2008. In view of the foregoing amendments and following remarks, Applicants respectfully submit that all pending claims in the application are in condition for allowance.

Turning now to the Official Action, Claims 15-22, 29-41 and 43 stand rejected under 35 U.S.C. § 112, first paragraph, for purportedly not being supported by the specification. For at least the reasons that follow, withdrawal of the rejection is in order.

The Official Action takes issue with the pending claims' use of the term "substituted" and argues that because the specification does not provide a specific description of all possible substituents, that the claims do not meet the requirement

of § 112, first paragraph. Applicants do not agree with the Official Action's rationale for the rejection because the specification provides exemplary guidance as to the type of substituents that may be used in the claimed method and because persons of ordinary skill in the field would be able to easily identify other suitable, known substituents without undue experimentation, it is believed that the claims are in fact sufficiently supported by the specification to meet the requirements of § 112, first paragraph. Specifically, the test for enablement is whether one skilled in the art could make or use the claimed subject matter from the disclosure of the application coupled with information known in the art, without undue experimentation. (See, M.P.E.P. § 2164.01.) "The scope of enablement . . . is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill in the art without undue experimentation." (Emphasis added.) (See, *National Recovery Technologies, Co. v. Magnetic Separation Systems, Inc.*, 49 U.S.P.Q.2d 1671 (Fed. Cir. 1999).) The specification is not required to provide all information that would be used by one of ordinary skill in the art to make and use the invention. Applicants can rely on general knowledge in the art to render a disclosure enabling. A specification need not, and preferably omits, that which is known in the art. (See, *In re Buchner*, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991).)

Nevertheless, in an effort to expedite prosecution of the application, Applicants have amended the claim to read, in part, ". . . wherein R<sub>1</sub> and R<sub>2</sub> which are different or identical, are alkyl groups having 8 to 20 carbon atoms . . ." Support for this amendment can be found at least at page 10, lines 24-26 of the specification.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the § 112, first paragraph, rejection of Claims 15-22, 29-41 and 43.

Claims 15-22 and 29-43 stand rejected under 35 U.S.C. § 112, first paragraph, for purportedly failing to comply with the written description requirement. For at least the reasons that follow, withdrawal of the rejection is in order.

The Official Action rejects the claims for not complying with the written description requirement of § 112, first paragraph, because the Official Action believes that the claims improperly recite that the adhesive emulsion (rather than the isocyanate) has a polydispersity index of not more than 1.5 (or in some instances not more than 1.3).

In an effort to expedite prosecution of the application, Applicants amended the claims (where appropriate) to indicate that the isocyanate has the claimed polydispersity index of not more than 1.5 or 1.3. Support for this amendment can be found at least at page 23, lines 10-15.

The Official Action also raises an issue with respect to the formula provided in independent Claims 15 and 30. Applicants have amended the claims in accordance with the Examiner's suggestion, to include the formula for the surfactant presented at page 9, lines 30-32 of the specification.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the § 112, first paragraph, written description rejection of Claims 15-22 and 29-43.

Claims 15-22 and 29-43 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. For at least the reasons that follow, withdrawal of the rejection is in order.

The Official Action rejects the claims for the use of a broad range or limitation together with a narrow range or limitation that falls within the broad range or

limitation (in the same claim). However, upon reviewing the claims presently pending in the application, it appears that the § 112, second paragraph, rejection for the use of a broad and narrow range in the same claim has already been addressed by the amendments presented in Applicants' Amendment of December 24, 2008. Accordingly, it appears that no further claim amendments are needed to address the rejection. If, however, Applicants have overlooked a claim that is still affected by this issue, Applicants would be pleased to consider the Examiner's further proposals.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph, rejection of Claims 15-22 and 29-43.

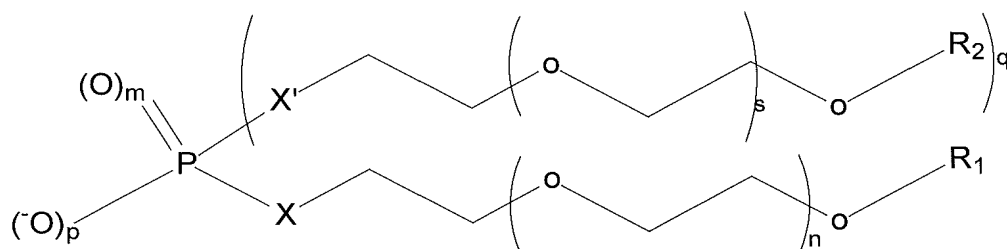
Claims 15-22 and 29-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Probst (U.S. Patent No. 6,528,573) in combination with Nabavi (U.S. Patent Application Publication No. 2001/0021746). For at least the reasons that follow, withdrawal of the rejection is in order.

Independent Claim 15 recites a method for using an adhesive emulsion, the method comprising:

applying the adhesive emulsion to join together at least two surfaces, wherein the adhesive emulsion comprises:

an isocyanate composition (a) with a mass content of N=C=O function of between 10% and 30% and with a viscosity of not more than 2500 mPa.s;

a surfactant (b) comprising a compound or a mixture of compounds of mean general formula:



wherein:

p represents a value between 1 and 2;

m represents zero or 1;

the sum  $p+m+q$  is equal to 3;

the sum  $1+p+2m+q$  is equal to 3 or 5;

X is an oxygen;

X' is an oxygen;

n and s have the same statistical value, chosen between 5 and 30,

wherein  $R_1$  and  $R_2$ , which are different or identical, are alkyl groups having 8 to 20 carbon atoms; and

an aqueous phase with a pH of between 4 and 9, optionally bearing an adhesive polymer,

wherein the isocyanate composition (a), the surfactant (b), and the aqueous phase optionally bearing an adhesive polymer are added simultaneously or successively to form the adhesive emulsion, and

wherein the adhesive emulsion includes particles having a particle size  $d_{50}$  of not more than 25  $\mu\text{m}$ , and the isocyanate has a polydispersity index of not more than 1.5. (Emphasis added.)

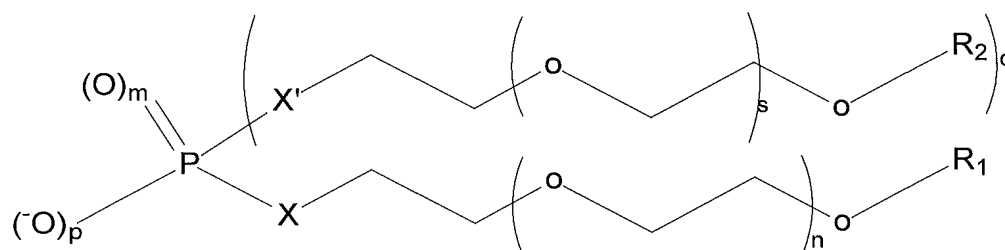
Independent Claim 30 recites a method for using an adhesive emulsion, the method comprising:

applying the adhesive emulsion to join together at least two surfaces, wherein the adhesive emulsion comprises:

an isocyanate composition (a) with a mass content of N=C=O function of between 10% and 30% and with a viscosity of not more than 2500 mPa.s,

wherein the isocyanate composition (a) further comprises a portion ranging from 5% to 20% by mass of reactive solvent comprising at least one molecule chosen from dimers, bis-dimers, monoallophanates, polymethylene diisocyanates and di-, tri- or tetrafunctional monomers with a molecular mass at least equal to 200;

a surfactant (b) comprising a compound or a mixture of compounds of mean general formula:



wherein:

p represents a value between 1 and 2;

m represents zero or 1;

the sum  $p+m+q$  is equal to 3;

the sum  $1+p+2m+q$  is equal to 3 or 5;

X is an oxygen;

X' is an oxygen;

n and s have the same statistical value of between 5 and 30,

wherein  $R_1$  and  $R_2$ , which are different or identical, are alkyl groups having 8 to 20 carbon atoms; and

an aqueous phase with a pH of between 4 and 9, optionally bearing an adhesive polymer,

wherein the isocyanate composition (a), the surfactant (b), and the aqueous phase optionally bearing an adhesive polymer are added simultaneously or successively to form the adhesive emulsion, and

wherein the adhesive emulsion includes particles having a particle size  $d_{50}$  of not more than 25  $\mu\text{m}$  and, and the isocyanate has a polydispersity index of not more than 1.5. (Emphasis added.)

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim features. (See, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).) In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." (See, *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970. See also, M.P.E.P. § 2143.03.) Applicants submit that these requirements have not been met.

Probst relates to aqueous 2-component polyurethane systems, to a process for producing them, and to their use for the production of coatings having an enhanced impact strength and good resistance to solvents. (See, Probst at Col. 1, lines 8-11.)

Nabavi relates to isocyanate-based compounds and compositions (which may be partially masked, but this is not the preferred application) and also to their process for utilization, their utilization for producing coatings and coatings thus obtained. (See, Nabavi at Col. 1, paragraph [0001].)

Applicants submit that the asserted combination of references does not establish a *prima facie* case of obviousness because it does not teach or fairly suggest each of the features defined in the combination of features recited in independent Claims 15 and 30 including, for example, a method for using an adhesive emulsion wherein the emulsion is applied to join together at least two surfaces and wherein the emulsion comprises the specified isocyanate composition (a) and surfactant (b) wherein the emulsion includes particles having a size  $d_{50}$  of not more than 25  $\mu\text{m}$  and the isocyanate has a polydispersity of not more than 1.5.

Furthermore, in establishing a *prima facie* case of obviousness, it is incumbent upon the Patent Office to provide reasons *why* one of ordinary skill in the art would have been led to modify a prior art reference or combined reference teachings to arrive at the claimed subject matter. Applicants submit that in the present case, no such factors or motivation for combining Probst and Nabavi exist.

Specifically, Applicants submit that one looking for methods of using an adhesive emulsion to join together at least two surfaces would not have been motivated to look to methods directed to the application of coatings. In particular, despite the Official Action's remarks to the contrary, Applicants submit that the cited references are non-analogous prior art for at least the reason that the fields of adhesives and coatings are two distinct technical fields. Indeed, Applicants submit that generally there is no advantage to using an adhesive as a coating and that a coating (even one that can adhere to a substrate) cannot be used as adhesive to glue two or more objects together to yield a permanent unit. For example, one would not look to use wall paper glue (an adhesive) to repaint ones' automobile, nor would one look to install wall paper using a car enamel (coating).



The legal standard for determining what constitutes analogous art was set for in *In re Wood and Eversol*, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979), as follows:

“The determination that a reference is from a non-analogous art is therefore two-fold. First, we decide if the reference is within the field of the inventors’ endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.”

Here, Applicants submit that Nabavi is neither within the inventors’ endeavor (i.e., methods for adhering at least two surfaces) nor is it pertinent to the particular problem involved (i.e., the use of a suitable adhesive emulsion to join two or more surfaces). In the case of *Ex parte Dussaud*, 7 U.S.P.Q.2d 818, 819 (B.P.A.I. 1988), the Board of Patent Appeals and Interferences warned against the overbroad definition of the problem with which the inventor was involved. Additionally, in the case of *Ex Parte Murphy*, 217 U.S.P.Q. 479, 482 (B.P.A.I. 1982), the Board found that references cited in the rejection under 35 U.S.C. § 103 were not directed to the particular problem addressed by the inventor, and thus reached the same conclusion as in *Dussaud*, that the references were from non-analogous art.

For example, Applicants submit that when the test for analogous art as set for in *In re Wood* is applied, in light of the Board’s holdings in *Dussaud* and *Murphy*, to the “particular problem with which the inventor was involved,” it is clear that Nabavi is not within the field of the inventors’ endeavor and is not directed to the particular problem with which the inventors were involved. In particular, while Claim 1 is directed to a method for using an adhesive emulsion, the method comprising applying the adhesive emulsion to join together at least two surfaces, Nabavi is substantially directed to the application of paint or varnish coating, not to adhesive emulsions applied for the purpose of joining together two or more surfaces. (See,

Nabavi, for example, at page 9, paragraph [0165] which states that the subject matter disclosed in Nabavi makes it "possible to obtain coatings (especially paints or varnishes). . . .")

For at least these reasons, Claims 15 and 30 are patentable over the combination of Probst and Nabavi. The remaining claims, (Claims 16-22, 29, 31-33, 35-41 and 43) depend, directly or indirectly, from Claims 15 or 30 and are, therefore, also patentable over the asserted combination of references for at least the reasons that Claims 15 and 30 are patentable. Reconsideration and withdrawal of the § 103(a) rejection of Claims 15-22 and 29-43 over Probst in view of Nabavi are respectfully requested.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

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